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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,506	08/25/2003	Vijay Mital	MSFT-1949/301416.1	4218
41505 7590 10/15/2007 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER LIU, LIN	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 10/15/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/648,506

Applicant(s)

MITAL ET AL.

Examiner

Lin Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/25/2003 and 11/03/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is responsive to communications filed on 08/25/2003.

Claims 1- 23 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 and 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "consolidating" recited in claims 1 and 23 is a relative term, which renders the claim indefinite. It is unclear and vague as what applicant is referring it to as. Dependent claims 2-9 and 20-23 are also rejected under the same rationale.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-8, 10-17, and 19-23** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to **claim 1**, the instant claim is drawn towards a method for determining a plurality of actions to be performed in connection with a context entity. For

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a method claim to be found statutory, it must have a useful, concrete, and tangible result. In this case, the result of the instant claim is "determining for each of the related service entities...". This result is useful and concrete, but is not tangible. For a result to be tangible, it must have some real-world impact or be available for use outside of the system. Determining the related service entities is merely finding the related service entities without storing or displaying that finding, which means that the determining is never used or presented in a fashion that can be used.

Furthermore, with regard to **claim 1**, the instant claim recites a condition: "determining for each of the related service entities *if* an action is *available* to be performed...". Even if the applicant amends the instant claim around the tangible result rejection, if the recited condition was not to occur, there would still be no real-world result impact. In order for a method claim to be statutory, it must result in a useful, concrete and tangible result. Claims 2-8 are dependent claims of claim 1, thus they are rejected under the same reason.

With regard to **claim 10**, the instant claim recites a condition: "*if* the action is *available*, then providing the action to the application", if the recited condition was not to occur, there would be no real-world result impact. In order for a method claim to be statutory, it must result in a useful, concrete and tangible result. Claims 11-17 are dependent claims of claim 10, thus they are rejected under the same reason.

With regard to **claim 19**, the instant claim is directed toward a system with first and second application services, an action service and a context service, wherein all of these services could be implemented in software alone. Claims directed toward

software alone refer to functional descriptive material, which is per se non-statutory.

Claims 20-23 depend on claim 19, thus they are rejected under the same reason.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims **1-6, 8-16, 18-19 and 21-23** are rejected under 35 U.S.C. 102 (e) as being anticipated by **Tracey et al. (PGPUB: US 2003/0083917 A1)**.

With respect to **claim 1**, Tracey teaches a method for determining if a plurality of actions are available to be performed in connection with a context entity, the context entity being derived from a plurality of related service entities at a plurality of application services (Tracey, figures 1-3), the method comprising:

classifying actions for a plurality of service entities at the plurality of application services, each action being classified according to its availability (Tracey, figures 12-13 page 4, paragraph 80, page 7, paragraph 100, and page 17, paragraph 247);

matching the related service entities based on their attributes (Tracey, page 5, paragraphs 81-82);

consolidating the related service entities into the context entity (Tracey, page 10, paragraphs 164-167); and

determining for each of the related service entities if an action is available to be performed on the service entity at a corresponding application service based on a corresponding classification of the availability of the action (Tracey, figures 22-23, and page 18, paragraphs 264-266).

With respect to **claim 2**, Tracey teaches the method of claim 1, wherein classifying the actions comprises classifying the actions as optimistically available (Tracey, Figures 12-13, page 17, paragraph 247).

With respect to **claim 3**, Tracey teaches the method of claim 2, wherein classifying the actions as optimistically available comprises classifying the actions as available subject to a rule (Tracey, figures 22-23, and page 18, paragraphs 264-266).

With respect to **claim 4**, Tracey teaches the method of claim 1, wherein the classifying the actions comprises classifying the actions as available according to a rule (Tracey, figures 22-23, and page 18, paragraphs 264-266).

With respect to **claim 5**, Tracey teaches the method of claim 1, wherein classifying the actions as available according to a rule comprises classifying the actions as being available only if the rule is complied with (Tracey, figures 22-23, and page 18, paragraphs 264-266).

With respect to **claim 6**, Tracey teaches the method of claim 1, wherein the classifying the actions comprises classifying the actions as universally available (Tracey, Figures 12-13, page 17, paragraph 247).

With respect to **claim 8**, Tracey teaches the method of claim 1, further comprising matching an application entity to the context entity (Tracey, page 12, paragraphs 182-183).

With respect to **claim 9**, Tracey teaches the method of claim 8, further comprising providing a view at an application of the actions available to be performed on each of the related service entities at the application services (Tracey, fig. 8-10, page 15, paragraphs 219-225 and page 16, paragraphs 242-244).

In regard to **claim 10**, the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 10. By this rationale claim 10 is rejected.

With respect to **claim 11**, Tracey teaches the method of claim 10, comprising identifying that the associated context entity is derived from the first service entity and a second service entity at a second application service, the first service entity being related to the second service entity (Tracey, figures 1-3, page 8, paragraphs 141-142).

In regard to **claims 12-16**, the limitations of these claims are substantially the same as those in claims 2-6. Therefore the same rationale for rejecting claims 2-6 is used to reject claims 12-16. By this rationale claims 12-16 are rejected.

In regard to **claim 18**, the limitations of this claim are substantially the same as those in claim 9. Therefore the same rationale for rejecting claim 9 is used to reject claim 18. By this rationale claim 18 is rejected.

In regard to **claim 19**, the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 19. By this rationale claim 19 is rejected.

With respect to **claim 21**, Tracey teaches the system of claim 19, wherein said action service comprises a tracking mechanism to track performance of the first and the second actions (Tracey, abstract, pages 8-9, paragraph 142).

In regard to **claim 22**, the limitations of this claim are substantially the same as those in claim 8. Therefore the same rationale for rejecting claim 8 is used to reject claim 22. By this rationale claim 22 is rejected.

In regard to **claim 23**, the limitations of this claim are substantially the same as those in claim 9. Therefore the same rationale for rejecting claim 9 is used to reject claim 23. By this rationale claim 23 is rejected.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracey et al. (PGPUB: US 2003/0083917 A1) in view of Brendle et al. (PGPUB: US 2005/0021355 A1).



With respect to **claim 7**, Tracey teaches all the claimed limitations, except that he does not explicitly teach a method of determining if performance of the action will result in a conflict.

In the same field of endeavor, Brendle teaches a method of determining if performance of the action will result in a conflict (Brendle, page 11, paragraph 98).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of determining result conflict as taught by Brendle in Tracey's invention in order to prevent locking and provide consistent result (Brendle, page 11, paragraph 98).

In regard to **claims 17 and 20**, the limitations of these claims are substantially the same as those in claim 7. Therefore the same rationale for rejecting claim 7 is used to reject claims 17 and 20. By this rationale claims 17 and 20 are rejected.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Carlson et al. (PGPUB: US 2003/0135609 A1) discloses a method for determining a modification of a system resource configuration.
- Bata (PGPUB: US 2003/0097364 A1) discloses a method for data source flattening.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447.

The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LL.

  
JASON CARDONE  
SUPERVISORY PATENT EXAMINER